



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/609,017	06/30/2000	Jay S. Walker	00-055	2125

22927 7590 12/04/2002

WALKER DIGITAL
FIVE HIGH RIDGE PARK
STAMFORD, CT 06905

EXAMINER

BORISSOV, IGOR N

ART UNIT PAPER NUMBER

3629

DATE MAILED: 12/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/609,017	Applicant(s) WALKER ET AL.	
	Examiner Igor Borissov	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

Art Unit: 3629

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-2, 3-14 and 33 are rejected under 35 U.S.C. 101 because the claimed method for referring postings does not recite a useful, concrete and tangible result under *In re Alappat*, 31 USPQ2d 1545 (Fed. Cir. 1994) and *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 47 USPQ2d 1596 (Fed. Cir. 1998). The independently claimed steps of receiving information regarding whether at least two medicine containers were able to communicate, determining a level to which the party complied with a medicine schedule, and rewarding the party based on the level are abstract ideas which can be performed mentally without interaction of a physical structure or are mere data storage devices that do not implement a useful, concrete and tangible result of a machine. Because the independently claimed invention is directed to an abstract idea which does not produce a useful, concrete and tangible result, those claims and claims depending from them, are not permitted under 35 USC 101 as being related to non-statutory subject matter. However, in order to consider those claims in light of the prior art, examiner will assume that those claims recite statutorily permitted subject matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

Art Unit: 3629

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 15 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Reber et al. (US 5,950,632).

Reber et al. teach a system and method for medical communication apparatus, comprising:

As per claim 15,

- receiving a signal from a device that monitors whether a first container for storing a first medicine and a second container for storing a second medicine are positioned so as to communicate (column 2, line 41 through column 6, line 53);

- determining if at least one party has complied with a schedule for taking the first medicine and the second medicine based at least in part on the received signal (column 2, lines 43-44; column 5, lines 32-36; column 8, lines 28-45, 55-62; column 9, lines 9-25; column 11, lines 33-40; column 13, lines 60-63).

As per claim 17, said method wherein determining if at least one party has complied with a schedule for taking the first medicine and the second medicine based at least in part on the received signal comprises:

Art Unit: 3629

- receiving first information regarding the first medicine and the second medicine (column 7, line 60 through column 10, line 54);
- receiving second information regarding the first medicine and the second medicine from the received signal (column 7, line 60 through column 10, line 54);
- comparing the first information to the second information (column 7, line 60 through column 10, line 54);
- generating at least an indicator of a level to which the at least one party has complied with a schedule for taking the first medicine and the second medicine based on the comparison of the first and the second information (column 7, line 60 through column 10, line 54).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 18-23 and 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reber et al. in view of Brown (US 6,151,586).

As per claims 1-2, 18-19, 22, 30 and 32-33 Reber et al. teach said system and method, comprising:

- receiving encrypted information regarding whether at least two medicine containers were able to communicate during a pre-determined time period (column 2, line 41 through column 6, line 53);
- determining a level to which the party complied with a medicine schedule based on the

information (column 7, line 60 through column 10, line 54).

However, Reber et al. do not teach rewarding the party for compliance with said schedule.

Brown teaches a computerized reward system and method for encouraging in a health management program wherein a compliance data on individuals is evaluated, and the reward to be given to the compliant individual (Abstract; column 3, lines 18-60).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Reber et al. to include rewarding the party for compliance with a medicine schedule because it would stimulate and discipline patients to comply with health management program thereby allowing physicians to determine the best way of treatment for the patients more accurately.

As per claim 21, Reber et al. and Brown disclose all the limitations of claim 21, except that rewarding for complying with the schedule comprises providing the at least one party with a reward selected by at least one of a representative of an insurance company and a representative of a medical facility.

It would have been an obvious matter of design choice to modify Reber et al. and Brown to include that rewarding for complying with the schedule comprises providing the at least one party with a reward selected by at least one of a representative of an insurance company and a representative of a medical facility because it appears that the claimed features do not distinguish the invention over similar features in the prior art, and the teachings of Reber et al. and Brown would perform the invention as claimed by the applicant with any third party to select a reward.

Art Unit: 3629

As per claim 23, Reber et al. and Brown disclose all the limitations of claim 22, except that a first reward based on a distance between the first container and the second container, and a second reward based on at least one other indicator that the at least one party has complied with the schedule for taking the first medicine and the second medicine.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Reber et al. and Brown to include that a first reward based on a distance between the first container and the second container, and a second reward based on at least one other indicator that the at least one party has complied with the schedule for taking the first medicine and the second medicine because it would stimulate and discipline patients to comply with health management program thereby allowing physicians to determine the best way of treatment for the patients more accurately.

As per claim 31, Brown teaches said system and method wherein the reward comprises a discount on a product (Abstract; column 23, lines 46-57).

Claims 3-14, 16 and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reber et al. in view of Andrews (US 5,757,271).

As per claims 3-5, 11, 16 and 26, Reber et al. teach said system and method, comprising:

- receiving the signal from a device that monitors whether the first container and the second container are positioned so as to wirelessly communicate (column 2, line 41 through column 6, line 53);
- determining whether a first container for storing a first medicine was positioned so as to wirelessly communicate for storing a second medicine based at least in part on the signal (column 2, line 41 through column 6, line 53).

Art Unit: 3629

However, Reber et al. do not teach that the first container wirelessly communicates with the second container.

Andrews teaches a system and method for providing security for an electronic device wherein a first security device wirelessly communicates with a second security device to determine whether or not the second security device is within a selected proximity of the first security device (Abstract).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Reber et al. to include that the first container wirelessly communicates with the second container because it would enhance the security of the system and increase accuracy of determining compliance of the patients with the prescribed schedule of taking medicine.

As per claim 6, Reber et al. teach said system and method wherein receiving the signal from a device that monitors whether the first container and the second container are positioned so as to wirelessly communicate comprises polling the device (column 3, lines 9-34; column 7, lines 55-59; column 10, lines 47-48).

As per claim 7, Reber et al. teach said system and method wherein receiving a signal comprises receiving a signal from at least one of a representative of a pharmacy, a representative of a medical facility and a party that is to take at least one of the first and the second medicines (column 3, lines 9-25; column 7, line 60 through column 10, line 54).

As per claim 8-10, Reber et al. teach said system and method wherein receiving a signal comprises receiving an encrypted code (column 4, lines 23-26; column 7, lines 11-42; column 9, lines 54-65).

Art Unit: 3629

As per claims 12 and 27, Reber et al. teach said system and method, comprising determining if at least one party has complied with a schedule for taking the first medicine and the second medicine based at least in part on the received signal (column 7, line 60 through column 10, line 54).

As per claim 13, Reber et al. teach said system and method wherein determining if at least one party has complied with a schedule for taking the first medicine and the second medicine based at least in part on the received signal comprises:

- receiving first information regarding a prescribed schedule for taking the first medicine and the second medicine (column 9, line 51 through column 10, line 54);
- receiving second information regarding a schedule for taking the first medicine and the second medicine adhered to by the at least one party (column 9, line 51 through column 10, line 54);
- comparing the first information to the second information (column 9, line 51 through column 10, line 54);
- generating at least an indicator of a level to which the at least one party has complied with a schedule for taking the first medicine and the second medicine (column 9, line 51 through column 10, line 54).

As per claim 13, Reber et al. teach said system and method wherein obtaining first information regarding the first medicine and the second medicine comprises obtaining the first information from at least one of a representative of a pharmacy, a representative of a medical facility and a representative of a manufacturer of at least one of the first and the second medicines (column 3, lines 9-25; column 7, line 60 through column 10, line 54).

Art Unit: 3629

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reber et al. and Brown in view of Bro (US 5,722,418).

As per claim 20, Reber et al. and Brown teach all the limitation of claim 20, except for providing the at least one party with a list of rewards; receiving a selection of one of the listed rewards; and providing the selected reward to the at least one party.

Bro teaches a system and method for mediating social and behavioral processes in medicine wherein a patient lists rewards he would receive for his behavior (column 41, lines 30-33).

It would have been obvious for one having ordinary skill in the art at the time the invention was made to modify Reber et al. and Brown to include providing the at least one party with a list of rewards because it would stimulate patients to comply with health management program thereby allowing physicians to determine the best way of treatment for the patients more accurately.

Claims 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reber et al. in view of Daansen et al. (US 6,375,038).

As per claims 24 and 25, Reber et al. teach all the limitations of claims 24 and 25, except for penalizing the at least one party if the at least one party has not complied with the schedule.

Daansen et al. teach a system and method for promoting compliance with proper washing techniques, wherein employers may be fined if employees do not comply with Food Code regulations (Abstract; column 1, line 54 through column 2, line 16).

It would have been obvious for one having ordinary skill in the art at the time the invention was made to modify Reber et al. to include penalizing a party or charging the party for

Art Unit: 3629

at least the portion of a treatment if the party has not complied with the schedule because it would discipline patients to comply with health management program thereby allowing physicians to determine the best way of treatment for the patients more accurately.

Claims 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reber et al. and Andrews in view of Brown.

As per claims 28 and 29, Reber et al. and Andrews teach all the limitations of claims 28 and 29, except for a server adapted to: receive the data output by the compliance monitoring device; and reward at least one party based on the received data.

Brown teaches said system, comprising a server for receiving the compliance data, and method, comprising the step of rewarding at least one party based on the received data.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Reber et al. and Andrews to include a server adapted to receive the data output by the compliance monitoring device; and rewarding a party based on the compliance data because it would enhance the capability of the system, and stimulate patients to comply with health management program thereby allowing physicians to determine the best way of treatment for the patients more accurately.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding

Art Unit: 3629

should be directed to the Receptionist whose telephone number is (703) 308-1113.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308- 2702.

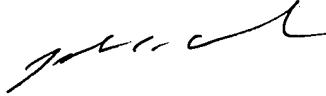
Any response to this action should be mailed to:

*Commissioner of Patents and Trademarks
Washington D.C. 20231*

or faxed to:

(703) 305-7687 [Official communications; including
After Final communications labeled
"Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,
Arlington, VA, 7th floor receptionist.


JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600